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09/991,748	11/23/2001	Jeffery M. Enright	D-1112 R4	7030
28995	7590	10/09/2007		
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			EXAMINER POINVIL, FRANTZY	
			ART UNIT 3692	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

Application Number: 09/991,748  
Filing Date: November 23, 2001  
Appellant(s): ENRIGHT, JEFFERY M.

OCT 09 2007

**GROUP 3600**

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Ralph E. Jocke  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 21, 2007 appealing from the Office action mailed October 19, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

US Patent Application No. 09/414,290 Appeal No. 2007-3366

US Patent Application No. 10/603,266 Appeal No. 2007-0069

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Stinson et al. (US Patent No. 6,149,056).

As per claims 1, 17, 26-28 and 36-39, Stinson et al disclose a system and method for providing an automatic check cashing system using biometric verification means. The system and method comprise:

(a) providing in an automated banking machine a document requiring a signature to achieve a legal effect (see the abstract);

(b) receiving at least one input from a user of the machine indicative that the user agrees that the user's electronic signature shall include data corresponding to at least one image of at least a portion of the user and acquiring the data corresponding to at least one image

of the user through operation of the machine. See the abstract, column 7, line 30 to column 8, line 50 and column 9, line 35 to column 12, line 40.

The system of Stinson et al further includes at least one input device on the machine, at least one image acquisition device and at least one controller in operation with the data store. See columns 5-7 of Stinson et al. Stinson et al further teach a marking device operative to apply to the document indicia corresponding to the at least one image.

As per claims 2-8, 20 and 31-34, Stinson et al disclose applying indicia or machine readable indicia from the user or signature of the user corresponding to the at least one image of the document or check wherein the indicia comprises a visual representation of at least a portion of the user, a visual representation of the user's face an image of the user's face, an image of a fingerprint of the user and an image of an iris of the user. See column 8, lines 11-44.

As per claim 9, Stinson et al disclose producing an electronic representation of at least one portion of the document with an imaging device in the system. See column 3, line 65 to column 4, line 4.

As per claims 10-11, 21-23 and 29-30, Stinson et al disclose storing in at least one data store, the electronic representation of the at least one portion of the document in correlated relation with the data corresponding to the at least one image of the user and data corresponding to the at least one input in correlated relation with the data corresponding to the at least one image. See column 8, lines 11-50 and column 9, lines 35-64 and column 11, line 60 to column 12, line 39.

As per claim 12, Stinson et al disclose delivering the document from the machine to the user if the user does not endorse the check or document. See column 7, lines 55-65

As per claim 13, Stinson et al disclose that the ATM machines can be used as a stand alone unit thereby being able to store the document therein. See column 5, lines 43-63.

As per claim 14 Stinson et al disclose the document comprises a negotiable instrument such as cash delivered by the user to the machine.

As per claims 15 and 18, Stinson et al disclose the user provides at least one input to the machine indicating that the data corresponding to the at least one image shall constitute endorsement of the negotiable instrument. See the abstract and column 7, lines 55-65.

As per claim 16, Stinson et al disclose applying indicia corresponding to the at least one image to the document responsive to the at least one input. See columns 7-9 of Stinson et al.

As per claim 19, Stinson et al disclose that a check is received in the machine from the user. See columns 7-8.

As per claims 24-25, Stinson et al disclose the at least one image is acquired through operation of a camera or a biometric reading device. See column 8, lines 11-44.

#### **(10) Response to Argument**

Appellant states that Stinson et al do not mention, or need “electronic signature” as required in their independent claims 1, 17, 26, 36 and 37 because in Stinson et al., the customer signs the check before it is even inserted in the machine.

In response, the appellant’s interpretation of “electronic signature” is defined as any operation of the user as being captured by a camera. The electronic signature may also be the image of a body portion of the user. See page 66, lines 5-9 of the appellant’s specification where it is stated “Automated banking machines or other devices may enable a user to agree that an

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image may serve as their electronic signature”, and on page 67, lines 5-7 of the appellant’s specification where it is stated that “Instead of signing a document to indicate agreement, the user may indicate one or more inputs through one or more inputs through one or more input devices on the banking machine that their image or portion thereof will be electronic signature”. Thus whether a check signed by a user of the system of Stinson et al is done before arriving at the ATM of Stinson et al or while using the ATM of Stinson is irrelevant when establishing a teaching or similarity of an electronic signature between the Appellant’s electronic signature and an electronic signature in Stinson et al. because an electronic signature as described is not a handwritten signature or a signing of a document. Thus, Stinson et al at column 5, lines 35-49 clearly teaches capturing the image of the user at an ATM while cashing a check and that image must be validated before funds are dispensed to the user. See column 2, lines 13-30 of Stinson et al. Thus, the captured image data of the user as done in the system of Stinson et al. is similar to the claimed “electronic signature”. Applicant is creating clouds as to the meaning of “electronic signature”.

Appellant then argues that Stinson does not receive an agreement input (regarding electronic signature) from a user of the machine.

In response, in the system of Stinson, an image of the user must be captured and compared to an image of the user which is stored in a remote computer and to be correlated with the check being cashed by the user. If not, the check will not be cashed. Whether an agreement to capture the image of the user is not stated in Stinson, the Examiner asserts that such is an inherent feature in the system of Stinson et al because:

1) the camera is not hidden and the camera is not a surveillance camera as such the camera is part of the transaction being performed by the user so as to allow the check to be cashed (see column 2, lines 13-30 and column 5, lines 35-49 of Stinson et al.);

2) the user clearly sees the camera and is responsive to the camera (see column 5, lines 35-49, column 7, line 65 to column 8, line 39 of Stinson et al.);

3) the customer in attempting to using the system is aware that a previous image of his/her self was previously taken prior to any transaction and that upon the act of performing a transaction, a new image of that same user must also be retaken in order for a transaction to finalize. See column 4, lines 2-14 and column 8, lines 6-39 of Stinson et al.

Thus, an agreement that the user must accept to acknowledge that their image at the ATM constitute an electronic signature is an inherent feature in the system of Stinson et al. (because the electronic signature is not a handwritten scanned signature) and also because a user has the knowledge that such an authorization must be realized in order to perform a transaction.

Appellant then argues that if Stinson et al use a customer's handwritten signature, then why would Stinson et al. need a user's "agreement" to use electronic signature for purposes of signing the document.

In response, an electronic signature is not a physical signature or an electronic signature generated by the computer as the appellant is leading one to believe. An electronic signature as indicated is an agreement to take an image of the customer which then represents an agreement that a transaction is/was performed by that user. It is clearly noted that Stinson et al.do provide such a teaching in order to enable a transaction to proceed and also in order to identify who or which customer has performed a particular transaction. Querying the user and the user accepting



such a condition is an inherent feature in the system of Stinson et al because the customer is aware that an image of himself or herself will be taken and he/she must agree that such an action is performed in order to perform a valid transaction.

Appellant states that a hand written signature teaches away from any need for electronic signature or any need for an electronic signature agreement from a user.

In response, Stinson et al clearly state (and as it is well known in the banking industry) before a check is cashed, the check must be endorsed or signed by the recipient of that check. The signing of a check is a general requirement. Stinson et al. additionally require the image of the customer cashing the check so as to allow that transaction to realize and to provide the related funds to the customer. Thus, the capturing of the image of the customer is the electronic signature.

The appellant then states that even if Stinson et al. somehow taught that the user has/had agreed to authorization, the agreement would not have been received via input from a user of the machine.

In response, Stinson et al. clearly instruct a customer to remove his/her hat before capturing the image of that customer. See column 7, line 65 to column 8, line 39 of Stinson et al.

Appellant queries as to where it is disclosed that the ATM of Stinson et al. controls or operates the camera.

In response, the appellant is arguing issues not being claimed. Furthermore, it is the ATM which instructs the customer to remove his/her hat before the image of the customer is taken.

Appellant argues that Stinson et al do not teach applying indicia corresponding to

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user image to a document.

In response, Stinson et al do apply indicia corresponding to a user image to check by correlating the check with the image of the user. Applying indicia corresponding to a user image to a document does not construe or imply printing the user image to a document. The user image correlates with the transaction or check being cashed.

All dependent claims are met by Stinson et al. as noted above.

**(11) Related Proceeding(s) Appendix**

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



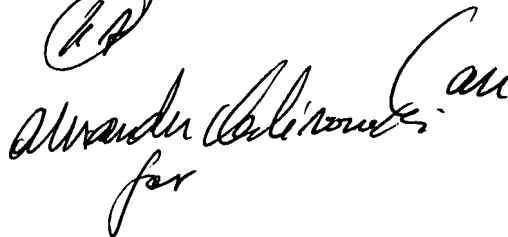
**Frantzy Poinvil**  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEFFERY M. ENRIGHT, KEVIN F. MARTIN,  
BRAD STEPHENSON, ROY HATHAWAY,  
TOM KEHNER, CHRISTOPHER J. KNOUFF,  
KENNETH C. VARN, JEFFREY R. THOMAS,  
JAY PAUL DRUMMOND, JOHN KORTIS,  
DAVID A. CRANE, EVAN F. GOLDRING,  
ROBERT NOVITSKEY, MICHAEL RUSSELL,  
MICHAEL MOTT, CHRIS DIVITA,  
AND DOUG WILLIAMS

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Appeal 2007-0069  
Application 10/603,266<sup>1</sup>  
Technology Center 2600

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Decided: May 3, 2007

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Before KENNETH W. HAIRSTON, JAY P. LUCAS, and  
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

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<sup>1</sup> Application filed June 23, 2003. Appellant claims the benefit under 35 U.S.C. § 119 of provisional application 60/103731, filed 10/09/1998. Application 10/603,266 is a divisional of 09/414,249, filed 10/07/1999. The real party in interest is Diebold, Incorporated, an Ohio corporation.

## DECISION ON APPEAL

### STATEMENT OF CASE

Appellants appeal from a final rejection of claims 1 and 68 to 89 under authority of 35 U.S.C. § 134 (2002). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants' invention relates to a method and apparatus for taking an image of a check in an ATM type of machine, and producing a markup language document corresponding to indicia on the check.

Claims 1 and 87 are exemplary:

1. A method comprising the steps of:

- (a) receiving a check into an automated banking machine, the automated banking machine including a cash dispenser;
- (b) capturing an image including indicia on the check through operation of an imaging device in the machine;
- (c) operating at least one computer in operative connection with the imaging device to produce at least one markup language document corresponding to indicia on the check.

87. Apparatus comprising:

a check analysis terminal,

wherein the terminal includes at least one computer,

wherein the terminal includes at least one input device,

wherein the terminal includes at least one display device,  
at least one data store,

wherein the at least one data store includes check transaction data corresponding to at least one image captured of at least a portion of a check during a check receiving transaction at a cash dispensing automated banking machine,

wherein the at least one data store is in operative connection with the at least one computer,

wherein the at least one computer is operative to receive additional check transaction data in at least one markup language document,

wherein the at least one computer is operative to cause received check transaction data to be stored in the at least one data store, and

wherein the at least one computer is operative responsive to at least one input to the at least one input device to cause a visual representation corresponding to stored check transaction data to be output through the at least one display device.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Cook	5,860,068	Jan. 12, 1999
Gustin	5,897,625	Apr. 27, 1999
Anderson	6,209,095	Mar. 27, 2001

Group I: The Examiner rejected claims 1, 68 to 70 and 72 to 89 under 35 U.S.C. § 103(a) as being obvious over Gustin in view of Anderson.

Group II : The Examiner rejected claim 71 under 35 U.S.C. 103(a) as being obvious over Gustin in view of Anderson. This rejection originally also relied up the Cook reference, but that reference was later considered cumulative. (Answer 22). With that understanding, the rejections will be considered as a whole, on all remaining claims 1 and 68 to 89.

Appellants contend that the claimed subject matter is not rendered obvious by Gustin alone, or in combination with Anderson, for reasons to be discussed more fully below. The Examiner contends that each group of claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).<sup>2</sup>

We affirm the rejections.

#### ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting claims 1, and 68 to 89 under 35 U.S.C. § 103(a). The issue turns on whether there is a legally sufficient justification for combining the disclosures of Gustin and Anderson to meet the claimed limitations. More specifically, the issue is whether the teachings of markup language documents in Anderson can be combined with the ATM and image scanning teachings of Gustin to render the claims obvious under 35 U.S.C. § 103(a).

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<sup>2</sup> Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group, except as will be noted in this opinion. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See In re Young*, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991). *See also* 37 C.F.R. § 41.37(c)(1)(vii).

### FINDINGS OF FACT

Findings with respect to the rejection of claims 1, and 68 to 89 under 35 U.S.C. § 103(a) for being obvious over Gustin in view of Anderson.

1. Appellants have invented an improved ATM type automated banking machine where a deposited check is imaged through the operation of an imaging device in the machine. (Claim 1, Specification 41) This aspect of the invention was demonstrated by the Examiner to be part of the prior art, namely in the reference patent to Gustin (col. 13, top) and in the reference patent to Anderson (col. 7, ll. 41-50).
2. In addition to the image data of the scanned checks, the Appellants capture transaction data or other data using other components of the machine and correlate that other data with the image data representative of the scanned checks. (Specification, 58, ll. 10 ff). That data, which can be representative of indicia on the check, can be used to verify the genuineness of the checks. For example, signatures can be checked by this technique (58, bottom), checking the images against stored signature data (59, ll. 10-17). Other examples of the type of information that may be used for verification are presented in the Specification, such as on page 60, lines 10 to 20.
3. This information, transaction and image documents, may travel on networks (Appellants' Fig. 13, #234), including the Internet,



using standard protocols, such as TCP/intellectual property (Specification 24). Records can be in HTML, XML and other markup languages. (Specification 24, ll. 5-7 for the protocols). The nature of these documents is variously described. They may be images of the handwriting and signatures on checks (41, ll. 11-18) or other image data to be compared by eye or by machine (59, ll. 5-17). The data can also include transaction data related to the bill dispenser of the ATM, to the printing devices for printing transaction receipts and records, and instructions to control, coordinate and limit the operation of the transaction function devices within the ATM. (Specification 50 and 51, top). All of these references in the Specification were presented by the Appellants in relating independent claim 1 to the supporting disclosures in the Specification. (Br. 6). They are recited here to further an understanding of the scope of the claimed limitations.

4. In claim 1, and claims 86 to 89, the Briefs and Answer have focused on the meaning of the third limitation of claim 1, namely "...operating at least one computer in operative connection with the imaging device to produce at least one markup language document corresponding to indicia on the check." When this language is interpreted in view of the Specification, it becomes clear that the stated markup language document corresponding to indicia on the check need not be limited to only where a reference "converts an imaged paper

check to a markup language document”. (See Reply Br. 11 in which this was a major point of the Appellants.) The markup language document as claimed need only contain information corresponding to the information on the check. In the instant invention, as the terms are used in the Specification, this claimed “corresponding information” transferred according to standard Internet protocols can be image data and transaction data, suitably “wrapped” in HTTP and TCP/IP- tags. (See the citations in paragraph 3 above.)

5. In the Examiner’s Answer, pages 3 and 4, Examiner relates how Anderson discloses an electronic check system. In the teachings of Anderson, he “discloses that it is known to use a markup language to identify and generate financial markup language documents in order to provide a tagged structure of checks in order to implement a conventional well known web browser procedure for verification purposes in electronic transactions across the Internet.” (references omitted). In Anderson at columns 18, 19 and 28 are disclosures using markup languages to display transaction data, and images, as claimed and as disclosed by Appellants. As the reference Gustin teaches using TIFF images of checks and verifying signature and transaction data over networks (col. 13), and as Anderson addresses the same field of endeavor with the added teaching of the Internet and markup language protocols for the same image and transactional data, we find the rejection based

on the two references to be appropriate for rendering the claims obvious.

6. Claim 68: As the Examiner in his Answer points out, in Gustin the system and method receive inputs from the users of the ATM from whom a check is received (Gustin, col. 8) correlated to the nature of the check (e.g. the amount entered in a keypad). This is part of the transaction data for the markup language documents (Gustin, col. 12; Anderson, col. 30).
7. Claim 69-71: Gustin, in column 9 top, discloses the storing of transaction data. As described above, the encoding into markup language of that same data is taught by Anderson in column 19.
8. Claim 72: As described above, authenticating information can be merely the image of the check, or the signature on the check. Anderson teaches such information to be in markup language.
9. Claim 74, 75, 76, 77, 78, 79, and 80: As noted by the Examiner, Gustin in column 13, lines 25-45 *ff* meets the claimed limitations, including signature analysis at a remote location. Transfer by Anderson's Internet protocols discloses a browser interface. See column 16, line 10 *ff*. Note servers both in Gustin and Anderson, as described by the Examiner.
10. Claims 81-85: As stated in the rejection, we find Gustin in column 12, lines 55 *ff* teach scanning the terminal data for selected parameters, such as checking account numbers. Output

devices are described at remote locations in Gustin, column 13 and in Anderson.

### PRINCIPLES OF LAW

On appeal, Appellants bears the burden of showing that the Examiner has not established a legally sufficient basis for the rejection of the claims.

“In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.” Our reviewing court further states, “[t]he terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Texas Digital Sys. Inc v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003).

References within the statutory terms of 35 U.S.C. § 102 qualify as prior art for an obviousness determination only when analogous to the claimed invention. *In re Clay*, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796

F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); see also *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) and *In re Bigio*, 381 F.3d 1320, 72 USPQ2d 1209, 1212 (Fed. Cir. 2004).

### ANALYSIS

Appellant has contended that the Examiner erred in rejecting claims 1 and 68 to 89 under 35 U.S.C. § 103(a). Reviewing the findings of facts cited above, we find that the Examiner has correctly combined the teachings of two references in the same field of endeavor to render the claims obvious over the prior art. Gustin discloses an ATM machine with scanned images of submitted checks and other standard ATM features, plus connections to remote terminals for transferring the image data and transaction data. Anderson teaches using the Internet for similar communications, with the concomitant use of Internet protocols including documents in markup languages.

### CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 and 68 to 89. The rejection of those claims is affirmed.

### OTHER ISSUES

Examiner and Appellants are reminded that even when frustration over the examination process is high, decorum is expected and required by regulations and the standards of our profession.

Appeal 2007-0069  
Application 10/603,266

DECISION

The Examiner's rejection of claims 1 and 68 to 89 is Affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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